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REMARKS

In the Office Action the Examiner noted that claims 17, 22, 23, 28 and 29 are pending in the application, and the Examiner rejected all claims. By this Amendment, claims 28-29 have been cancelled without prejudice or disclaimer, and claims 17 and 22-23 have been amended. No new matter has been presented. Thus, claims 17 and 22-23 are pending in the application. The Examiner's rejections are traversed below, and reconsideration of all rejected claims is respectfully requested.

Entry of Amendment Under 37 C.F.R. §1.116

The Applicant requests entry of this Rule 116 Response because: the amendments were not earlier presented because the Applicant believed in good faith that the cited references did not disclose the present invention as previously claimed; the amendment of claim 17 and 22-23 should not entail any further search by the Examiner since no new features are being added and no new issues are being raised; and the amendment does not significantly alter the scope of the claim, and places the application at least into a better form for purposes of appeal. No new features or new issues are being raised.

The Manual of Patent Examining Procedures sets forth in Section 714.12 that "any amendment that would place the case either in condition for allowance or in better form for appeal may be entered." Moreover, Section 714.13 sets forth that "the Proposed Amendment should be given sufficient consideration to determine whether the claims are in condition for allowance and/or whether the issues on appeal are simplified." The Manual of Patent Examining Procedures further articulates that the reason for any non-entry should be explained expressly in the Advisory Action.

Claim Rejections Under 35 USC §103

On pages 3-4 of the Office Action the Examiner rejected claims 17, 22-23, and 28-29 under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 6,633,849, issued to Dodd (hereinafter referred to as "Dodd") in view of U.S. Patent Publication No. 2002/16734, issued to McGill (hereinafter referred to as "McGill"), and further in view of U.S. Patent Publication 2002/95298, issued to Ewing (hereinafter referred to as "Ewing"). By this Amendment, claims 28-29 have been cancelled without prejudice or disclaimer. The Applicants respectfully traverse the Examiner's rejections of the remaining claims.

Claim 17 of the present application, as amended, recites "the providing includes deciding

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whether the gift information is opened to the sender or not based on flag information included in the gift information, the flag information being set by the recipient." The Applicants respectfully submit that at least this feature is not disclosed or suggested by the cited references, either alone or in combination.

The Examiner acknowledged that neither Dodd nor McGill disclose deciding whether the gift information is opened to the sender or not based on flag information included in the gift information, the flag information being set by the recipient. The Examiner went on to state that Ewing discloses this feature in paragraph [0025] on page 2 of Ewing. However, the Applicants respectfully submit that Ewing does not disclose or suggest the feature cited by the Examiner, neither in the cited section nor in the remaining paragraphs of Ewing. To wit, paragraph [0025] of Ewing reads thusly:

In preparation for carrying out the method, the member-network management provides new members, upon sign-up, with a series of choices relating to a blind gift program. First, the new member is asked to check boxes or otherwise make choices to indicate, without limitation: whether gifts will ever be accepted from any anonymous or pseudonymous party; whether gifts will be accepted only from anonymous or pseudonymous parties who are members of the member-network; whether gifts will be accepted only from parties who identify themselves with true name and address information; whether gifts will be accepted from certain parties (listed by pseudonym or true name); whether gifts will be accepted only if they fall within certain parties (listed by pseudonym or true name); whether gifts will be accepted only if they fall within certain categories (e.g., only candy and flowers, but no lingerie); whether gifts costing more than a particular amount will be accepted; whether gifts should be delivered to the member's billing address, or to another address; and/or, whether certain categories of gifts will only be accepted from parties who identify themselves with true name and address information.

Therefore, Ewing merely discloses a series of choices which may be selected by a user to determine what types of gifts he or she receives, and in what manner the user will accept the gifts in a blind gift program. The choices relate to, for example, whether gifts will ever be accepted from any anonymous or pseudonymous party, and so on. Such a series of choices are made by the user for screening out certain gifts or givers of gifts, but does not disclose information that will be opened to the sender or not based on flag information set by the recipient. Rather, the profile established by the user will be utilized by the system, which essentially acts as a middle man in the blind gift system, to determine whether to allow a gift ordered by a sender to be sent to the recipient.

In other words, the sender is not provided with any of the gift information of the recipient, and further does not know of the limitations set by the recipient before placing the order. Rather, the sender places the order using a pseudonym of the recipient, and will not know until the system checks the user's profile whether or not the shipping of the gift will be completed. "Once

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the blind gift program obtains a gift choice or choices from the Gifto, the intended recipient member (the Giftee) will need to be identified" (Paragraph [0037]). Therefore, none of the gift information is able to be seen by the sender, and the sender can merely attempt to send the gift in the blind fashion disclosed in Ewing.

This is in direct contrast with claim 17, which recites a method for mediating an online gift before a sender places an order for a recipient, comprising "deciding whether the gift information is opened to the sender or not based on flag information included in the gift information." For example, in one embodiment of the method enabled by claim 17, and discussed at least in lines 16-25 on page 17 of the specification, a recipient can determine whether information about a best gift and a worst gift can be opened by a sender who is currently selecting a gift for that recipient. This allows the sender to avoid sending a "bad" gift. This is not possible in Ewing, because no gift information is made available to the sender, and certainly is not made available before the sender places an order for a recipient, as is claimed in claim 17.

Therefore, as the cited references do not disclose, either alone or in combination, at least the features of claim 17 discussed above, the Applicants respectfully submit that claim 17 patentably distinguishes over the cited references. Further, claims 22-23 also recite "deciding whether the gift information is opened to the sender or not based on flag information included in the gift information, the flag information being set by the recipient." Therefore, the Applicants respectfully submit that claims 22-23 also patentably distinguish over the cited references.

The Applicants also respectfully submit that there is no motivation to combine the cited references, even if the references did combine to disclose or suggest all the features of the present claims. The Examiner stated that it would have been obvious to include in Dodd/McGill the means for the recipient to place a flag to decide whether information is sent to a sender as taught by Ewing, because incorporating the method of Ewing creates a situation where being sent unwelcome gifts is minimized. However, as stated above, the gift information is not presented to a sender before attempting to send the gift. Also, because Dodd already allows a recipient to change the gift prior to delivery, there is apparently no problem of being sent unwelcome gifts as stated by the Examiner. Thus, the incorporation of Ewing would provide no benefit to the disclosure of Dodd. As there is no motivation to combine the cited references, the Applicants respectfully request the withdrawal of the Examiner's §103 rejections of claims 17 and 22-23.

Summary

In accordance with the foregoing, claims 28-29 have been cancelled without prejudice or

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disclaimer, and claims 17 and 22-23 have been amended. No new matter has been presented. Thus, claims 17 and 22-23 remain pending in the application.

There being no further outstanding objections or rejections, it is respectfully submitted that the application is in condition for allowance. An early action to that effect is courteously solicited.

Finally, if there are any formal matters remaining after this response, the Examiner is requested to telephone the undersigned to attend to these matters.

If there are any additional fees associated with filing of this Amendment, please charge the same to our Deposit Account No. 19-3935.

Respectfully submitted,

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09/11/06

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